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Response Under 37 C.F.R. § 1.116
Expedited Procedure, Group Art Unit 1733
PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#11/160E
6/6/03

In re Application of:)
MASAKI MIZUTANI, ET AL.)
Application No.: 09/813,137)
Filed: March 21, 2001)
For: METHOD OF PRODUCING)
SEMICONDUCTOR THIN)
FILM AND METHOD OF)
PRODUCING SOLAR CELL)
USING SAME)

Examiner: J. L. Goff II
Group Art Unit: 1733
May 30, 2003

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO OFFICE ACTION

Sir:

This is in response to the Office Action dated April 22, 2003 (Paper No. 10). Claims 19, 21, 27, 29 and 30 are in the application, with Claims 21, 27 and 29 being withdrawn from consideration pursuant to an election of species requirement. Claims 19, 21, 27 and 30 are the independent claims. Reconsideration and further examination are respectfully requested.

Claims 19 and 30 stand rejected under the judicially created doctrine of obviousness-type double patenting over Claims 1, 3, 6 and 7 of U.S. Patent No. 6,258,666 ('666 patent) in view of U.S. Patent No. 6,100,166 (Sakaguchi) in view of U.S. Patent No. 5,397,713 (Hamamoto). The rejection is respectfully traversed.

Applicants submit that in view of an earlier-issued restriction requirement, the Examiner is estopped from claiming that the present invention is a mere double patenting of the claims of the '666 patent.

In parent Application No. 09/333,019, now the '666 patent, restriction was imposed between the claims of Group I, drawn to a method of producing a semiconductor thin film, classified in class 438, subclass 71, and the claims of Group II, drawn to a method of producing a solar cell, classified in class 136, subclass 243. The restriction requirement was entered pursuant to the guidelines of MPEP § 806.05(c), which permits restriction between a combination and subcombination if it can be shown that the combination does not require the particulars of the subcombination for patentability and that the subcombination has separate utility. Applicants elected Group II, without prejudice to filing a divisional application for the non-elected group. Claims directed to Group II subsequently issued in the '666 patent. As a result of the restriction requirement, this divisional application was filed to seek patent protection, *inter alia*, for the subject matter of non-elected Group I.

The Examiner is estopped from raising double patenting, based on 35 U.S.C. 121, third sentence, which provides:

A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed

as a result of such a requirement, shall not be used as a reference either in the Patent and Trademark Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application.

More guidance can be found in the Manual of Patent Examining Procedure.

Section 804.01, in pertinent part, states:

The prohibition against holdings of double patenting applies to requirements for restriction between the related subjects treated in MPEP 806.04 through 806.05(i). . . , so long as the claims in each case are filed as a result of such requirement. . . The following are situations where the prohibition of double patenting rejection under 35 U.S.C. 121 does not apply: . . . (B) The claims of the different applications or patents are not consonant with the restriction requirement made by the examiner, since the claims have been changed in material respects from the claims at the time the requirement was made. For example, the divisional application filed includes additional claims not consonant in scope to the original claims subject to restriction in the parent. In order for consonance to exist, the line of demarcation between the independent and distinct inventions identified by the examiner in the requirement for restriction must be maintained (citations omitted).

Thus, in the instant case, a double patenting rejection over the '666 patent is prohibited so long as Claims 19 and 30 are consonant in scope to the claims subject to restriction. They are. Claims 19 and 30 have not been so amended as to cross the line of demarcation drawn between the inventions identified in the restriction requirement.

In the Amendment dated February 4, 2003, Applicants amended independent Claims 19 and 30 to include a feature recited by dependent Claims 20, 22 and 28, which in turn were cancelled. In particular, Claims 19 and 30 were amended to contain the feature of a rotating thin film support member having a curved surface. It is clear that Claims 19 and 30, as amended, are consonant in scope to cancelled Claims 20, 22 and 28, claims which were subject to restriction in the parent case. Merely incorporating

subject matter from a restricted-out dependent claim into a restricted-out independent claim cannot render the independent claim non-consonant with the restriction requirement.

Although the Examiner might disagree with the restriction requirement with respect to Claims 20, 22 and 28, such disagreement is irrelevant. Applicants properly acquiesced in the restriction requirement and cannot now be penalized for that acquiescence. As pointed out in MPEP § 804.01, the protection afforded by 35 U.S.C. 121 "imposes a heavy burden on the Office to guard against erroneous requirements for restrictions."

In view of the foregoing, reconsideration and withdrawal of the double patenting rejection are respectfully requested.

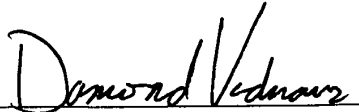
If the double patenting rejection is maintained, the Examiner is respectfully requested to cite specific Patent and Trademark Office rules or case law which supports a proposition that the incorporation of subject matter from a dependent claim into an independent claim (both of which were restricted out in the parent case) can somehow obviate the protection afforded by 35 U.S.C. 121.

With regard to the claims withdrawn from consideration pursuant to an election of species requirement, Applicants submit that Claim 30 is generic to Species I-A (Claim 19), Species I-B (Claim 21), and Species II (Claims 27 and 29). Generic Claim 30 is believed to be allowable and upon its allowance, Applicants submit that they are entitled to allowance of all claims directed to the species which are encompassed by generic Claim 30. See MPEP § 806.04(d).

No other matters being raised, it is believed that the entire application is fully in condition for allowance, and such action is courteously solicited.

Applicants' undersigned attorney may be reached in our Costa Mesa,
California office at (714) 540-8700. All correspondence should continue to be directed to
our below-listed address.

Respectfully submitted,


Attorney for Applicants

Registration No. 52,310

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-2200
Facsimile: (212) 218-2200

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